

# Notice of Allowability

Application No.

10/817,449

Examiner

Eric S. Olson

Applicant(s)

ZI ET AL.

Art Unit

1623

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Applicant's communication submitted May 16, 2007.
2. ☒ The allowed claim(s) is/are 1 and 20-26.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

**Detailed Action**

This office action is a response to applicant's communication submitted May 16, 2007 wherein claim 1 is amended, claims 8-19 are cancelled, and new claims 22-26 are introduced. This application claims benefit of provisional application 60/459495 filed April 1, 2003.

The reasons for allowance will be discussed below.

The reasons for allowance and Examiner's Amendment are as follows:

### Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Robert Buyan on June 19, 2007.

The claims have been amended as follows:

- Claims 2-7 are cancelled.
- In claim 1, line 8, the chemical name 2',4,6'-trihydroxy-4-methoxy-3'-prenylchalcone (Xanthogalenol) is changed to:  
2',4,6'-trihydroxy-4'-methoxy-3'-prenylchalcone (Xanthogalenol)

Additionally, the specification is amended as follows:

- The chemical species recited on p. 11, line 31 of the specification is amended to read:  
vii) 2',4,6'-trihydroxy-4'-methoxy-3'-prenylchalcone (Xanthogalenol)

***Reasons for Allowance***

Currently, claims 1 and 20-26 are pending in this application and have been examined on the merits herein. The therapeutic methods described in the instant claims are not seen to be taught or fairly suggested by the prior art.

Reasons for allowance are as follows: The claimed therapeutic methods are adequately described by the specification, for example p. 11, lines 5-31, in such a way as to enable one skilled in the art to make and use the claimed invention. The disclosed chalcone compounds can be readily obtained or synthesized by one skilled in the art, as discussed on p. 14, lines 12-25 of the instant specification. Pp. 17-19 provide an example demonstrating the antiproliferative effects of these compounds.

The claimed therapeutic methods are not seen to be taught or fairly suggested by the prior art. While certain prior art publications, such as Chen, Gerhauser et al., or Sunkara et al. (References of record in previous office action) disclose chalcones having antiproliferative activity, the five specific species recited in instant claim 1 are not known in the prior art as being useful for treating bladder cancer. Furthermore, there would be no motivation for one of ordinary skill in the art to modify these compounds to produce the specific compounds recited in the instant claims.

For these reasons, the subject matter is allowable over the prior art.

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Accordingly, Applicant's amendment submitted May 16, 2007, and the enclosed examiner's amendment, is sufficient to remove all rejections made in the prior office action as discussed above and to place the application in condition for allowance.

Any comments considered necessary by Applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled, "Comments on Statement of Reasons for Allowance."


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric S. Olson whose telephone number is 571-272-9051. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Anna Jiang can be reached on (571)272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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6/19/07



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